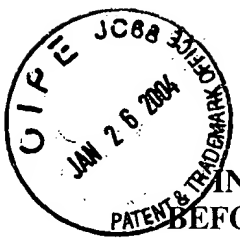
Image

AF/A 2800



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Nobufumi MORI, et al.

Docket No: Q65170

Appln. No.: 09/887,334

Group Art Unit: 2854

Confirmation No.: 5953

Examiner: Stephen R. FUNK

Filed: June 25, 2001

For:

PLANOGRAPHIC PRINTING PRESS

SUBMISSION OF APPELLANT'S BRIEF ON APPEAL

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an original and two copies of Appellant's Brief on Appeal. A check for the statutory fee of $330.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

Allison M. Tulino

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Allison M. Tulino
Registration No. 48,294

Date: January 26, 2004

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APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 1.192, Appellant submits the following:

I. REAL PARTY IN INTEREST

Based on information supplied by Appellant and to the best of the Appellant's legal representative's knowledge, the real party in interest is the assignee, FUJI PHOTO FILM Co., LTD.

II. RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences known to Appellant, Appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

Claims 13, 16 and 20 stand rejected under 35 U.S.C. § 102(b), and claims 14, 15, 19, 21 and 22 stand rejected under 35 U.S.C. § 103(a). Claims 17, 18 and 23-25 contain allowable subject matter, and claims 1-12 are withdrawn.

IV. STATUS OF AMENDMENTS

Subsequent to the June 25, 2003 Amendment, Appellant canceled withdrawn claims 1-12. However, as noted in the October 14, 2003 Advisory Action, the Examiner did not enter the amendment, stating that the cancellation of the withdrawn claims does not place the application in better form for appeal.

V. SUMMARY OF THE INVENTION

Fig. 2 shows an illustrative, non-limiting embodiment of the invention which relates to a planographic printing press. The planographic printing press contains, for example, a plate cylinder 1 having an original printing plate, a hydrophobic processing section 2 for applying a hydrophobic layer on the original plate, and an activation light irradiating section 5 for irradiating activation light on the original plate, as per image, to form a master plate (pg. 66, line 20 to pg. 67, line 5 of Application). Further, an ink and damping supplying section 3 is provided for supplying ink and a damping solution to the master plate on the plate cylinder 1, and a blanket cylinder 6 which transfers ink retained on the master plate to sheets of paper (pg. 67, lines 7-13 of Application).

The hydrophobic processing section 2 is provided with a heater and a temperature controller (pg. 67, line 5-7 and pg. 68, line 25 to pg. 69, line 3 of Application). The hydrophobic processing agent or layer is heated to a vaporizing temperature, supplied to the surface of the original plate, and condensed on the surface thereof, to form a hydrophobic film (pg. 68, lines 3-6 of Application). The heater heats the original plate, having the hydrophobic layer, to an appointed temperature of 40 through 200 °C (pg. 70, lines 16-23 of Application). Activation light is irradiated onto the original plate having the appointed temperature, by the activation light irradiating section (pg. 70, lines 23-26 of Application).

VI. ISSUES

1. Whether claims 13, 16 and 20 are anticipated by JP 2000-062335 to Suda ("Suda")?

2. Whether claims 14, 15, 19, 21 and 22, as they depend from claim 13, are unpatentable over Suda in view of U.S. Patent No. 6,048,654 to Nakayama et al. ("Nakayama")?

VII. GROUPING OF CLAIMS

Claims 13, 14, 15, 16 and 19-22 stand or fall together.

VIII. ARGUMENTS

A. Claims 13, 16 and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Suda. Appellant submits that the rejection is improper.

1. Claim 13

Claim 13 recites a "means" for heating an original plate during irradiating of an activation light so that the temperature of the surface of the original plate becomes 40 through 200 °C, as per image, and on the entire surface thereof, so that a hydrophobic area and a hydrophilic area are formed on the original plate. Appellant submits that the means-plus-function limitation requires the Examiner to give patentable weight to the function of the recitation (*See* 35 U.S.C. § 112, sixth paragraph, and MPEP § 2184).

The application of a prior art reference to a means or step plus function limitation requires that the prior art perform the identical function specified in the claim (MPEP § 2182). If a prior art reference teaches the identical function specified in the claim, then the Examiner carries the initial burden of proof to show that the prior art structure is equivalent to the structure described in the specification, which has been identified as corresponding to the claimed means (MPEP § 2182).

Accordingly, when making out a prima facie case of equivalence, an Examiner must first find that a prior art element:

A) performs the function specified in the claim,

B) is not excluded by any explicit definition provided in the specification for an equivalent, and

C) is an equivalent of the means or step-plus-function limitation (MPEP § 2183).

Similar to the September 25, 2003 Amendment, Appellant submits that the Examiner has failed to establish that dryer 17 of Suda performs the identical function specified in claim 13, i.e., heating an original plate during irradiating of an activation light (pg. 8). For example, Suda discloses a printing machine 10 having a drum 13, a write-in equipment 15, inking roller 16, and a dryer 17 (Fig. 6; para. [0048]). Suda fails to disclose that dryer 17 is activated during activation of write-in equipment 15 (i.e., the alleged activation light irradiation section). Rather, as disclosed, the dryer 17 is activated prior to the write-in equipment 15. For example, as stated in paragraph [0049] of Suda, after "hydrophobing" [sic][1] processing liquid is applied to the plate by coating equipment 12, the dryer 17 is activated to dry the "hydrophobing" [sic] processing liquid (Fig. 6). Then, after the liquid is dried, a picture is written on the plate by ultraviolet rays emitted by write-in equipment 15 (para. [0049]).

Since dryer 17 of Suda does not perform the identical function as the claimed "means", Appellant submits that the Examiner has failed to establish a prima facie case of equivalence.

Although no prima facie case of equivalence has been established, the Examiner maintains that if hydrophobic processing section 2 of Fig. 2 of the present invention can heat during irradiation of light irradiating section 5, then dryer 17 of Suda can also heat during

[1] Due to the computer translation of the Suda reference (Japan Patent Office website), Appellant assumes the term "hydrophobing" is intended to recite "hydrophobic."

irradiation of write-in equipment 15 (Continuation sheet of October 14, 2003 Advisory Action). Further, the Examiner maintains that in an apparatus claim, it is only required that the structure per se is similar (Continuation sheet of October 14, 2003 Advisory Action). However, since the means limitation of claim 13 falls under 35 U.S.C. § 112, sixth paragraph, Appellant submits that the Examiner's statement is in error. In addition, based on the Examiner's statements regarding Fig. 2 of the present invention, it appears that the Examiner is maintaining that dryer 17 is an equivalent of Appellant's hydrophobic processing section 2 (even though dryer 17 of Suda fails to perform the identical function specified in claim 13).

Factors which support a conclusion that a prior art element is an equivalent, are set forth in MPEP §2183. Based on the Examiner's statements in the Advisory Action, it appears that the Examiner is focusing on factor (D) of MPEP § 2183. Factor (D) states that there is support for a conclusion that a prior art element is an equivalent, if the prior art element is a structural equivalent of the corresponding element disclosed in the specification. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). However, this factor requires that the prior art element perform the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification (MPEP § 2183). For example, "unless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. § 112, sixth paragraph." *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 961 (1988).

As stated above in the Summary of the Invention, the hydrophobic processing section 2, shown in the non-limiting embodiment of Fig. 2, includes a heater and temperature control mechanism, such that temperature is adjusted in the recited range of claim 13 (pg. 70, lines 16-23 of Application). Further, the activation light is irradiated onto the original plate which is adjusted to the appointed temperature (pg. 70, lines 23-26 of Application). Therefore, Appellant submits that the function specified in claim 13 can be performed by the hydrophobic processing section 2 of Fig. 2 of the present invention. Moreover, since dryer 17 of Suda does not heat during irradiation, Appellant submits that dryer 17 cannot be a structural equivalent to the heater of the hydrophobic processing section 2, (i.e., Since it does not perform the identical function specified by claim 13, it cannot be an equivalent for the purposes of 35 U.S.C. § 112, sixth paragraph. *See Id.*).

Based on the foregoing, Appellant submits that the Examiner has failed to establish a prima facie case of equivalence.

Accordingly, Appellant respectfully requests the Board to reverse the rejection under 35 U.S.C. § 102(b).

2. Claims 16 and 20

Since claims 16 and 20 depend upon claim 13, Appellant submits that such claims are patentable at least by virtue of their dependency.

B. Claims 14, 15, 19, 21 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Suda in view of Nakayama. However, since claims 14, 15, 19, 21 and 22 are dependent upon claim 13, and Nakayama fails to cure the deficient teachings of Suda, Appellant submits that such claims are patentable at least by virtue of their dependency.

IX. Conclusion

The present Brief on Appeal is being filed in triplicate. Unless a check is submitted herewith for the fee required under 37 C.F.R. §1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Allison M. Tulino
Registration No. 48,294

Date: January 26, 2004

APPENDIX

CLAIMS 13-16 and 19-22 ON APPEAL:

13. (Previously presented) A planographic printing press, comprising:

a mounting section which mounts an original printing plate having photo catalyst power;

a processing section which hydrophobically processes the entire surface of said original plate on which a layer of a hydrophobic substance is provided;

an activation light irradiation section which irradiates activation light one of on said original printing plate carrying the layer of said hydrophobic substance as per image and on the entire surface thereof;

means for heating said original plate during irradiating said activation light so that the temperature of the surface of said original plate becomes 40 through 200°C one of as per image and on the entire surface thereof, so that a hydrophobic area and a hydrophilic area are formed on said original plate;

a section which supplies ink to said hydrophobic area and which supplies a damping solution to said hydrophilic area; and

a printing section which prints by bringing a printing surface, on which said hydrophobic area accepts the ink and said hydrophilic area accepts the damping solution, into contact with a surface to be printed.

14. (Previously presented) The planographic printing press according to Claim 13, wherein said heating means includes a heating device for heating said original printing plate by irradiating light for maintaining the surface of said original printing plate at a predetermined

temperature.

15. (Previously presented) The planographic printing press according to Claim 13, wherein said heating means includes a heating device for heating said original printing plate by electric heating for maintaining the surface of said original printing plate at a predetermined temperature.

16. (Previously presented) The planographic printing press according to claim 13, wherein the mounting section comprises a plate cylinder.

19. (Previously presented) The planographic printing press according to claim 13, wherein the activation light irradiation section comprises a mercury lamp as a light source for the activation light.

20. (Previously presented) The planographic printing press according to claim 13, wherein the activation light contains ultraviolet ray components.

21. (Previously presented) The planographic printing press according to claim 13, wherein the activation light irradiation section comprises a laser beam source for emitting a laser beam and a laser bean source driving section.

22. (Previously presented) The planographic printing press according to claim 21, wherein the laser beam is a helium cadmium laser.

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There are no other related appeals or interferences known to Appellant, Appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

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Claims 13, 16 and 20 stand rejected under 35 U.S.C. § 102(b), and claims 14, 15, 19, 21 and 22 stand rejected under 35 U.S.C. § 103(a). Claims 17, 18 and 23-25 contain allowable subject matter, and claims 1-12 are withdrawn.

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Fig. 2 shows an illustrative, non-limiting embodiment of the invention which relates to a planographic printing press. The planographic printing press contains, for example, a plate cylinder 1 having an original printing plate, a hydrophobic processing section 2 for applying a hydrophobic layer on the original plate, and an activation light irradiating section 5 for irradiating activation light on the original plate, as per image, to form a master plate (pg. 66, line 20 to pg. 67, line 5 of Application). Further, an ink and damping supplying section 3 is provided for supplying ink and a damping solution to the master plate on the plate cylinder 1, and a blanket cylinder 6 which transfers ink retained on the master plate to sheets of paper (pg. 67, lines 7-13 of Application).

The hydrophobic processing section 2 is provided with a heater and a temperature controller (pg. 67, line 5-7 and pg. 68, line 25 to pg. 69, line 3 of Application). The hydrophobic processing agent or layer is heated to a vaporizing temperature, supplied to the surface of the original plate, and condensed on the surface thereof, to form a hydrophobic film (pg. 68, lines 3-6 of Application). The heater heats the original plate, having the hydrophobic layer, to an appointed temperature of 40 through 200 °C (pg. 70, lines 16-23 of Application). Activation light is irradiated onto the original plate having the appointed temperature, by the activation light irradiating section (pg. 70, lines 23-26 of Application).

VI. ISSUES

1. Whether claims 13, 16 and 20 are anticipated by JP 2000-062335 to Suda ("Suda")?

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The application of a prior art reference to a means or step plus function limitation requires that the prior art perform the identical function specified in the claim (MPEP § 2182). If a prior art reference teaches the identical function specified in the claim, then the Examiner carries the initial burden of proof to show that the prior art structure is equivalent to the structure described in the specification, which has been identified as corresponding to the claimed means (MPEP § 2182).

Accordingly, when making out a prima facie case of equivalence, an Examiner must first find that a prior art element:

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Although no prima facie case of equivalence has been established, the Examiner maintains that if hydrophobic processing section 2 of Fig. 2 of the present invention can heat during irradiation of light irradiating section 5, then dryer 17 of Suda can also heat during

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As stated above in the Summary of the Invention, the hydrophobic processing section 2, shown in the non-limiting embodiment of Fig. 2, includes a heater and temperature control mechanism, such that temperature is adjusted in the recited range of claim 13 (pg. 70, lines 16-23 of Application). Further, the activation light is irradiated onto the original plate which is adjusted to the appointed temperature (pg. 70, lines 23-26 of Application). Therefore, Appellant submits that the function specified in claim 13 can be performed by the hydrophobic processing section 2 of Fig. 2 of the present invention. Moreover, since dryer 17 of Suda does not heat during irradiation, Appellant submits that dryer 17 cannot be a structural equivalent to the heater of the hydrophobic processing section 2, (i.e., Since it does not perform the identical function specified by claim 13, it cannot be an equivalent for the purposes of 35 U.S.C. § 112, sixth paragraph. *See Id.*).

Based on the foregoing, Appellant submits that the Examiner has failed to establish a prima facie case of equivalence.

Accordingly, Appellant respectfully requests the Board to reverse the rejection under 35 U.S.C. § 102(b).

2. Claims 16 and 20

Since claims 16 and 20 depend upon claim 13, Appellant submits that such claims are patentable at least by virtue of their dependency.

B. Claims 14, 15, 19, 21 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Suda in view of Nakayama. However, since claims 14, 15, 19, 21 and 22 are dependent upon claim 13, and Nakayama fails to cure the deficient teachings of Suda, Appellant submits that such claims are patentable at least by virtue of their dependency.

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